

REMARKS

The Office Action Summary indicates that claims 1-65 are pending in the present application and that claims 2-4, 6-17, 19-58 and 60-65 have been withdrawn from consideration. Applicants respectfully note that claims 60-65 were canceled in the Response to Restriction Requirement Under 37 C.F.R. § 1.142 and Election of Species Under 37 C.F.R. § 1.146 filed on May 26, 2005. Accordingly, Applicants believe that claims 1-59 were pending.

Claims 2-4, 6-18, 21, 44-54 and 57 have been canceled as redundant or inconsistent with amended claim 1. The claims have been canceled without prejudice to Applicants' right to pursue the subject matter of the canceled claims in related applications.

Claim 1 has been amended to clarify that which Applicants regard as the invention. Specifically, claim 1 has been amended to recite:

A is proline, B is histidine, C is serine;

R³ is -CH₂CONH₂;

R¹ is acyl, substituted acyl, oxycarbonyl, or substituted oxycarbonyl;

a, b, x, y and z are 1;

m is 1 or 2; and

R⁴ is NH₂.

Claims 5, 22, 55, and 58 have been amended to correct dependencies and delete redundant subject matter in view of the canceled claims. Claim 55 also has been amended to add a period at the end of the claim. Claim 56 has been amended to correct an improper dependency. Claim 59 has been amended to add dependencies.

Support for these amendments can be found in the specification, for example, at page 18, lines 16-32 and page 45, lines 6-8. These amendments are made without prejudice. Applicants reserve the right to prosecute the deleted subject matter in related applications.

Applicants believe that no new matter is added by this amendment.

After entry of this amendment, claims 1, 5, 19, 20, 22-43, 55, 56, 58 and 59 will be pending.

Entry of the foregoing amendments and consideration of these remarks are respectfully requested.

Claim Rejections - 35 U.S.C. § 112

Claims 1, 5, 18, and 59 were rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Examiner contends that claim 1 is rendered vague and indefinite by the proviso phrase “a is 1 unless A is proline, B is histidine, C is serine and b is 0 when a is 0” because it is unclear if the statement “b is 0 when a is 0” is connected exclusively to the event when a is 0 and A is proline, B is histidine and C is serine.

In response, without admitting to the propriety of the rejection, Applicants have deleted the proviso phrase “a is 1 unless A is proline, B is histidine, C is serine and b is 0 when a is 0.” Accordingly, the rejection under 35 U.S.C. § 112 has been obviated.

Claim Rejections - 35 U.S.C. § 102

Claims 1, 5, 18, and 59 were rejected under 35 U.S.C 102(b) as allegedly being anticipated by Kondo et al. (WO 98/30538). Specifically, the Examiner contends that Kondo teaches a compound of Formula (I) wherein a is 1, b = 0, x = 0, y = 0, z = 0, R² is - (CH₂)_mS(O)_nR⁵, m = 1, n = 0, R⁵ = aryl (Phe), R¹ is substituted oxycarbonyl (CO-O-Phe) and R⁴ is -OR⁸, wherein R⁸ is alkyl(Me).

In response, without admitting to the propriety of the rejection, Applicants have amended claim 1 to recite, inter alia, that a, b, x, y and z are 1. As the compound taught in Kondo recites that b, x, y and z are 0, Kondo does not anticipate claim 1 as amended.

Accordingly, Applicants respectfully request the withdrawal of the rejection.

Double Patenting

The Examiner has provisionally rejected claims 1, 5, 18, and 59 under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 64-70 of co-pending Application No. 10/723,843 (the “’843 application”). Specifically, the Examiner contends that the conflicting claims are not patentably distinct from each other because the presently claimed invention and the invention claimed in the ’843 application are both drawn to peptide compounds of Formula (I) and Formula (V), respectively, which claim at least one or more overlapping species. The

Examiner further contends that the instantly claimed product encompasses and/or is encompassed by the claimed product of the '843 application. Applicants respectfully disagree.

The legal standard for an obviousness-type double patenting rejection requires a comparison of what is *claimed* in the earlier patent, not what was disclosed in the specification of the earlier patent. See *e.g.*, *General Foods, Inc. v. Studiengesellschaft Köhle mbH*, 972 F.2d 1272, 1280-81 (Fed. Cir. 1992). Although the specification may be used to determine the meaning of terms used in the claims, the specification may not be used as prior art. See *e.g.*, *In re Vogel*, 422 F.2d 438 (C.C.P.A. 1970).

Applicants respectfully submit that claims 64-70 of the '843 application, which are directed to compounds of formula (V), do not render obvious the claimed compounds of formula (I). In particular, Applicants submit that the compounds of formula (I) are not obvious over the compounds of formula (V), because formula (V) requires that at least one of R³⁰, R³¹ or R³² is present and is a therapeutic agent, and there is no teaching or suggestion in the claims of the '843 application of a compound without a conjugated therapeutic agent. Moreover, claims 64-70 of the '843 application do not teach or suggest a compound within the scope of the presently claimed invention. The present claims are directed to compounds which are not recited to be conjugated to a therapeutic agent, whereas the claims of the '843 application recite compounds which are conjugated to a therapeutic agent.

Thus, Applicants respectfully submit that claims 1, 5, 18 and 59 are patentably distinct from claims 64-70 of the '843 application.

For the above reasons, Applicants respectfully request withdrawal of the double patenting rejection.

CONCLUSION

Applicants respectfully request that the present remarks be made of record in the instant application. If any issues remain in connection herewith, the Examiner is respectfully invited to telephone the undersigned to discuss the same.

Respectfully submitted,

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